

Busse, Reed F.

S/N: 10/612,596

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Species I", as disclosed on page 4, paragraph 3, lines 17-23. Though the restriction is believed to be deficient, Applicant believes claims 1-10 read on "Species I."

REMARKS

The Examiner has identified four "species." The classification of the "species" included Species I, as disclosed on page 4, paragraph 3, lines 17-23, Species II, as disclosed on page 4, paragraph 4, lines 24-26 and page 5, lines 1-2, Species III, as disclosed on page 5, lines 3-4, and Species IV, as disclosed on page 5, lines 5-14.

In defining the various species of the restriction, the Examiner cited four paragraphs of the Brief Description of the Invention section of the Application, each corresponding to a separate "species." Three of those paragraphs are virtually verbatim recitations of the three independent claims of the present Application. A comparison of the claims and corresponding paragraphs quickly elucidates that they are substantially identical. Species I, paragraph 3 of page 4, corresponds to claim 1, Species II, paragraph 4 of page 4, corresponds to claim 11, Species III, lns. 3-4 of page 5, corresponds to claims 14 and 23, and Species IV, lns. 5-14 of page 5, corresponds to claim 18. Thus, the Examiner has effectively restricted claims to species and has not identified embodiments restricted to species. However, MPEP §806.04(c) is very clear when it states that "[c]laims are never species.... Species are always the specifically different embodiments." (Emphasis in original). It appears that the restriction attempts to circumvent this section by restricting paragraphs of the Application duplicated from the claims. Such a manner of restriction is improper, unsustainable, and must be withdrawn.

Furthermore, an inspection of the species and their corresponding claims, beyond mere preamble language, shows that the purported species are substantially related in function, organization, and essential elements. As a result, the identified species are not independent and there is no serious burden on the Examiner. The term "independent" is described in MPEP §802.01 as "no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect." The identified species are not independent since relationship abounds in the design, operation, and effect of the purported "species" of the present invention.

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For example, the paragraphs cited as defining Species I, II, and IV all include a pulse sequence for an MRI system to reduce induced RF power by having a first set of pulses with high flip angle, then a second set of pulses with lower flip angle. *See* pg. 4, lns. 1-16, and claims 1, 11, and 18. The Manual of Patent Examining Procedure §806.03 states that “[w]here the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.” (Emphasis added). Thus, the simple fact that the claims apparently corresponding to the identified “species” are drafted as independent claims is not a basis for considering species to be independent. Simply, claim independence is not the same as independence of invention or species. *Id.* Additionally, a serious burden on the Examiner is required for restriction to be proper. MPEP §803. Since the identified species have not been shown to be independent and, in fact, are not independent, MPEP §803 has not been satisfied. *See* MPEP §808.01(a). Therefore, there is no basis to assert that examination of all species would constitute a serious burden on the Examiner.

When species are not independent, distinctness between the species must be proven. MPEP §806.04(b). The Examiner accordingly stated that “[t]his application contains claims directed to...patentably distinct species.” (Emphasis added). Distinctness implies that inventions are disclosed as related, but are patentable over each other. MPEP §802.01. Additionally, “claims to be restricted to different species must be mutually exclusive,” according to MPEP §806.04(f). As the Examiner has effectively restricted the claims to “distinct species,” the independent claims must be proven patentable over each other for restriction to be proper. However, upon review of the claims corresponding to the identified “species,” it is clear that distinctness is not present.

For example, claims 1 and 11, corresponding to Species I and II respectively, call for substantially similar elements. An examination of the elements of claim 1 and claim 11 shows that both call for 1) two groupings of pulses, 2) the first grouping of pulses to preserve contrast, 3) the first grouping of pulses to have relatively high flip angles, 4) the second grouping of pulses to have smaller flip angles than the pulses of the first set, and 5) the flip angles of the second grouping to generally vary over time. Thus, the substantial similarity between claim elements makes it plain that Species I and II are not distinct. Therefore, the Examiner has failed to satisfy the burden imposed by MPEP §806.04(b) and, accordingly, Species I and II must be rejoined.

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Furthermore, claims 1 and 11, corresponding to Species I/II, and claim 18, corresponding to Species IV, are likewise not distinct. Claim 18, like claims 1 and 11, calls for 1) two sets of pulses, 2) the first set having high nutation (i.e. flip angle) pulses, 3) the first set conserving contrast, and 4) the second set having lower nutation (i.e. flip angle) pulses. While claim 18 calls for MRI equipment in addition to the pulse sequence, Applicant does not contend that novelty exists in the specific equipment so as to make claim 18 patentable over claims 1 and 11. Therefore, Species I/II and Species IV have not been proven distinct and §806.04(b) has not been satisfied. As a result, Species I/II and Species IV must be rejoined.

The language of the paragraph identified as Species III corresponds to dependent claims 14 and 23. Therefore, Species III provides additional evidence that the restriction is unsustainable since it would be impossible to even elect Species III without also electing Species II and IV. Specifically, the Examiner defined Species III by citing lns. 3-4 of page 5 of the Application. The cited language is nearly identical to that of claims 14 and 23, the only two claims that read on Species III. Therefore, since these claims are dependent, Applicant would be unable to elect Species III alone because claims 14 and 23 incorporate all that is contained in Species II and Species IV respectively. Since Species III, alone as identified, is not an embodiment of the present invention, and since the claims reading thereon simply further define the invention as claimed in independent claims 11 and 18, Applicant believes that it is not proper to restrict the subject matter of claims 14 and 23 as corresponding to a separate species.

Additionally, since claims 14 and 23 corresponding to Species III incorporate, through dependency, all the elements of claims 11 and 18, corresponding to Species II and IV, respectively, Species III cannot be distinct from Species II and IV since Species III necessarily includes Species II and IV through the dependency of the corresponding claims. Therefore, none of the species identified by the Examiner has been proven distinct to warrant restriction.

In summary, the present restriction is improper since it effectively restricts claims and not embodiments, a pair of dependent claims was restricted as a species, and no serious burden has been shown by the Examiner. Therefore, restriction should not be required in the present invention since the identified species are related.

Applicant has amended claim 18 to correct typographical errors.

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Accordingly, Applicant respectfully requests rejoinder of all claims, of each species. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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